UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
TRAN, PHILIP B

ART UNIT	PAPER NUMBER
2155	

DATE MAILED: 02/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Office Action Summary	Application No.	Applicant(s)
		09/703,388	ARENS, DOUGLAS W.
		Examiner	**Art Unit**	
		Philip B Tran	2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _8/26/2004_.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-25_ is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-25_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

Response to Amendment

1.   This office action is in response to the amendment filed on 08/26/2004. Claims 1-9 and 24-25 have been amended. Therefore, pending claims 1-25 are presented for further examination.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3.   Claims 1 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, lines 1-5, the preamble of "... having devices that **may comprise** one or more servers, hubs, routers, clients and switches ..." and the limitation of "... which **may or may not be** a server, hub, router, client or switch ..." are being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 9, lines 4-5, the preamble of "... wherein the devices **may or may not be** a server, hub, router, client or switch ..." is being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Thus, the boldfaced phrases render the claims indefinite.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 1-6, 8-12, 14-17, 19-20 and 24-25 are rejected under 35 U.S.C 102(e) as

being anticipated by Li et al (Hereafter, Li), U.S. Pat. No. 6,012,088.

Regarding claim 1, Li teaches a network configuration (= configuring a computing

system for communication with a communications network) [see Abstract and Col. 1,

Lines 14-17] having devices that may comprises one or more servers, hubs, routers,

clients and switches, said configuration comprising:

a first device which may or may not be a server, hub, router, client or switch, and

which is unconfigured (= a not yet configured internet access device) [see Abstract and

Col. 9, Lines 20-24] and connected to the network (= internet access device (100)

connects to the internet) [see Abstract and Col. 9, Lines 13-17]; and

a second device that is configured and connected to the network (= a

configuration server (410) connects to the internet) [see Abstract and Figs. 8 & 9],

wherein the second device sends over the network at least a portion of its configuration

information, wherein a portion of said configuration information of said second device is

used by said first device to create its own configuration information (= downloading a

unique configuration record from the configuration server (410) and then the internet

access device (100) configuring itself for communication with the internet using the

configuration record) [see Abstract and Col. 12, Lines 43-48].

Regarding claim 2, Li further teaches said first device modifies the configuration

information of said second device received from said second device to create

configuration information for itself (= downloading a unique configuration record from the

configuration server (410) and then the internet access device (100) configuring itself for

communication with the internet using the configuration record [see Abstract and Col.

12, Lines 43-48] and displaying and error message or terminating the call procedure

[see Col. 12, Lines 62-65 and Col. 13, Lines 50-59] which will change the configuration).

Regarding claim 3, Li further teaches said first device is capable of sending over

the network a request for configuration information (= the internet access device (100)

requests a unique configuration record) [see Col. 12, Lines 43-48 and Col. 22, Lines 60-

63].

Regarding claim 4, Li further teaches said second device sends its configuration

information in response to the request for configuration information from said first device

(= downloading configuration record from the configuration server (410) to the internet

access device (100)) [see Col. 12, lines 43-48 and Col. 22, Lines 64-65].

Regarding claim 5, Li further teaches said configuration information for said first device is address configuration information (= the configuration record contains information such as addresses) [see Col. 14, lines 53-65].

Regarding claim 6, Li further teaches said configuration information created for said first device is the IP address of said first device (= the configuration record contains information such as IP addresses) [see Col. 14, Lines 53-65].

Regarding claim 8, Li further the configuration information create for said first device is created by said first device modifying the portion of said configuration information of said second device (= downloading a unique configuration record from the configuration server (410) and then the internet access device (100) configuring itself for communication with the internet using the configuration record [see Abstract and Col. 12, Lines 43-48] and displaying and error message or terminating the call procedure [see Col. 12, Lines 62-65 and Col. 13, Lines 50-59] which will change the configuration).

Regarding claim 9, Li teaches a computer-implemented method of transferring network information, including configuration information, between at least a first unconfigured device and a second configured device connected to the network (= configuring a computing system for communication with a communications network including downloading configuration information from a configuration server to a n

internet access device) [see Abstract and Col. 1, Lines 14-17] wherein the devices may or may not be a server, hub, router, client or switch, including the steps of:

sending from the second device that is connected to and configured for the network at least a portion of its configuration information on to the network (= a configuration server (410) connects to the internet [see Abstract and Figs. 8 & 9] and downloading a unique configuration record from the configuration server (410) to the internet access device) [see Col. 12, Lines 43-48]; and

the first device receiving the at least a portion of its configuration information and using a portion of the configuration information sent from the second device to create its own configuration information (= the internet access device (100) configuring itself for communication with the internet using the configuration record) [see Abstract and Col. 12, Lines 43-48].

Regarding claim 10, Li teaches the step of sending from the first device a request on the network for configuration information (= the internet access device (100) requests a unique configuration record) [see Col. 12, Lines 43-48 and Col. 22, Lines 60-63].

Regarding claim 11, Li further teaches the second device responds to the request from the first device for configuration information with at least a portion of its configuration information (= downloading configuration record from the configuration server (410) to the internet access device (100)) [see Col. 12, lines 43-48 and Col. 22, Lines 64-65].

Regarding claim 12, Li further teaches the step of determining whether to accept

the at least of portion of the configuration information from the second device (=

determining whether to download configuration record from the configuration server if

the configuration record exists) [see Fig. 11B].

Regarding claim 14, Li further teaches generating a subnet mask from the at

least a portion of configuration information of the second device (= configuration record

includes configuration information related to IP network such as IP network address and

an IP network mask) [see Col. 15, Lines 55-58].

Regarding claim 15, Li further teaches after the first device is configured, the

second device may respond to the first device with network information other than

configuration information (= once configured, the internet access device acts as a

router, communicating with the internet using a static IP address and a range of IP

addresses for other devices on a network [see Col. 3, Lines 57-61] and the mail, web,

time and other additional server are enabled with confirmation [see Col. 16, 57-59].

Regarding claim 16, Li further teaches the second device responds both with at

least a portion of its configuration information and other network information (=

downloading configuration record from the configuration server (410) to the internet

access device (100) [see Col. 12, Lines 43-48 and Col. 22, Lines 64-65] wherein the

configuration record contains information such as IP addresses and other network

information [see Col. 14, Lines 53-65]).

Regarding claim 17, Li further teaches the step of the second device responding

with the network information other than configuration information (= downloading

configuration record from the configuration server (410) to the internet access device

(100) [see Col. 12, Lines 43-48 and Col. 22, Lines 64-65] wherein the configuration

record contains information such as IP addresses and other network information [see

Col. 14, Lines 53-65]).

Regarding claim 19, Li further teaches communicating with second device or

other devices on the network that the first device that was previously unconfigured is

now configured and available for use (= a not yet configured internet access

device(100) [see Abstract and Col. 9, Lines 20-24] connects to the internet [see

Abstract and Col. 9, Lines 13-17] and downloads a unique configuration record from the

configuration server (410) and then the internet access device (100) configures itself for

communication with the internet using the configuration record [see Abstract and Col.

12, Lines 43-48]).

Regarding claim 20, Li further teaches the configuration information of the

second device is used to create an IP address for the first device (= the configuration

record contains information such as IP addresses) [see Col. 14, Lines 53-65].

Regarding claim 24, Li teaches a network configuration (= configuring a computing system for communication with a communications network) [see Abstract and Col. 1, Lines 14-17] comprising:

a first device that is unconfigured (= a not yet configured internet access device) [see Abstract and Col. 9, Lines 20-24] and connected to the network (= internet access device (100) connects to the internet) [see Abstract and Col. 9, Lines 13-17], said first device being capable of sending over the network a request for configuration information (= the internet access device is able to automatically locate a configuration server and request a unique configuration record) [see Col. 12, Lines 43-48]; and

a second device that is configured and connected to the network (= a configuration server (410) connects to the internet) [see Abstract and Figs. 8 & 9], wherein responsive to the request for configuration information from said first device, said second device responds with at least a portion of its configuration information, wherein a portion of the configuration information of said second device is used to create configuration information for said first device (= downloading a unique configuration record from the configuration server (410) and then the internet access device (100) configuring itself for communication with the internet using the configuration record) [see Abstract and Col. 12, Lines 43-48].

Regarding claim 25, Li teaches a computer-implemented method of transferring network information, including configuration information, between at least a first and

second device connected to the network (= configuring a computing system for communication with a communications network including downloading configuration information from a configuration server to a n internet access device) [see Abstract and Col. 1, Lines 14-17], including the steps of:

sending from the first device, wherein the first device is unconfigured (= a not yet configured internet access device) [see Abstract and Col. 9, Lines 20-24], a request on the network for configuration information (= the internet access device is able to automatically locate a configuration server and request a unique configuration record) [see Col. 12, Lines 43-48];

wherein a second device configured for the network (= a configuration server (410) connects to the internet) [see Abstract and Figs. 8 & 9], responsive to the request on the network for configuration information, responds with at least a portion of its configuration information; and

wherein the first device using a portion of the configuration information of the second device, creates it own configuration information (= downloading a unique configuration record from the configuration server (410) and then the internet access device (100) configuring itself for communication with the internet using the configuration record) [see Abstract and Col. 12, Lines 43-48].

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7.   Claim 7 is rejected under 35 U.S.C 103(a) as being unpatentable over Li et al (Hereafter, Li), U.S. Pat. No. 6,012,088 in view of Sandick et al (Hereafter, Sandick), U.S. Pat. No. 6,684,241.

Regarding claim 7, Li does not explicitly teach said second device is not required to be a server. However, Li does not teach the second device must be a server either.

Sandick, in the same field of configuring a network device endeavor, discloses the second device is a router [see Sandick, Figs. 2-3 and Col. 4, Lines 5-26 and Col. 7, Lines 50-66]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teaching of configuring a network device such as a router, disclosed by Sandick, into configuration for internet access device in a

network as disclosed by Li, in order to provide a more versatile system in handling tasks of configuring and managing an increasing complexity of network with a variety of different devices.

8.   Claim 13 is rejected under 35 U.S.C 103(a) as being unpatentable over Li et al (Hereafter, Li), U.S. Pat. No. 6,012,088 in view of Pham et al (Hereafter, Pham), U.S. Pat. No. 6,629,145.

Regarding claim 13, Li does not explicitly the step of determining whether configuration address information was received from a compatible device. However, Pham, in the same field of configuring network devices endeavor, discloses verifying if the IP address provided by the server (DHCP server) is compatible with the connected network [see Col. 2, Lines 33-39]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teaching of verifying if the IP address provided by the server is compatible, disclosed by Pham, into the teaching of configuring network devices as disclosed by Li, in order to enable communications among different devices in the network computer system [see Col. 2, Lines 33-39].

9.   Claim 18 is rejected under 35 U.S.C 103(a) as being unpatentable over Li et al (Hereafter, Li), U.S. Pat. No. 6,012,088 in view of Schmuelling et al (Hereafter, Schmuelling), U.S. Pat. No. 6,603,758.

Regarding claim 18, Li does not explicitly teach the other network information is SYSLOG information. However, Schmuelling, in the same field of internet access configuration, discloses SYSLOG system for logging informational or error messages [see Schmuelling, Col. 6, Lines 8-14]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the implementation of SYSLOG system, disclosed by Li, into the system of configuring and assigning IP address as disclosed by Li, in order to efficiently monitor and report error messages. ·

10.   Claim 21 is rejected under 35 U.S.C 103(a) as being unpatentable over Li et al (Hereafter, Li), U.S. Pat. No. 6,012,088 in view of Schmuelling et al (Hereafter, Schmuelling), U.S. Pat. No. 6,603,758 and further in view of Alkhatib et al (Hereafter, Alkhatib), U.S. Pat. No. 6,532,217.

Regarding claim 21, Li and Schmuelling do not explicitly teach the step of confirming that the IP address created for the first device is not currently in use. However, Alkhatib, in the same field of configuring network address endeavor, discloses determining if the address has not already been taken [see Alkhatib, Fig. 3A and Col. 9, Lines 39-47]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teachings of verifying IP address, disclosed by Alkhatib, into the system of configuring and assigning IP address as disclosed by Li, in order to avoid the conflict of duplicated IP addresses in the network.

11.   Claim 22 is rejected under 35 U.S.C 103(a) as being unpatentable over Li et al

(Hereafter, Li), U.S. Pat. No. 6,012,088 in view of Alkhatib et al (Hereafter, Alkhatib),

U.S. Pat. No. 6,532,217.

Regarding claim 22, Li does not explicitly teach the step of creating information

for the first device includes the step of combining a portion of a configuration address

information from the second device with a device portion address of the first device.

However, Alkhatib, in the same field of configuring network address endeavor, discloses

the chosen unique host number is combined with the subnet number to form the new

node's network address [see Alkhatib, Abstract]. It would have been obvious to one of

ordinary skill in the art at the time of the invention was made to incorporate the teaching

of combining the chosen unique host number with the subnet number, disclosed by

Alkhatib, into the system of configuring and assigning IP address as disclosed by Li, in

order to efficiently reconfigure the IP address and form a new IP address for the

unconfigured internet access device when the device just connects to the network.

12.   Claim 23 is rejected under 35 U.S.C 103(a) as being unpatentable over Li et al

(Hereafter, Li), U.S. Pat. No. 6,012,088 in view of Ford et al (Hereafter, Ford), U.S. Pat.

No. 6,687,755.

Regarding claim 23, Li does not explicitly teach the device portion address of the

first device is generated using a hash algorithm. However, Ford, in the same field of

configuring and assigning IP address endeavor, discloses the use of deterministic

hashing algorithm to generate the host portion of the IP address [see Ford, Col. 8, Lines

54-59]. It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to incorporate the implementation of generating the host portion of

the IP address using a deterministic hashing algorithm, disclosed by Ford, into the

system of configuring and assigning IP address as disclosed by Li, in order to result in

less usage conflicts for generating IP addresses [see Ford, Col. 9, Lines 1-4] because

using a deterministic hashing algorithm would have enabled the generation of random

IP addresses.

Response to Arguments

13.   Applicant's arguments have been fully considered but they are not persuasive

because of the following reasons:

In response to applicant's arguments, the law of anticipation requires that a

distinction be made between the invention described or taught and the invention

claimed. It does not require that the reference "teach" what the subject patent teaches.

Assuming that a reference is properly "prior art," it is only necessary that the claims

under consideration "read on" something disclosed in the reference, i.e., all limitations

of the claim are found in the reference, or "fully met" by it. *See Colman v. Kimberly-*

Clark Corp., **218 USPO 789.**

Li teaches configuring a computing system for communication with a

communications network [see Abstract and Col. 1, Lines 14-17] having devices that

may comprises one or more servers, hubs, routers, clients and switches, said

configuration comprising a first device which may or may not be a server, hub, router,

client or switch, and which is unconfigured. For example, Li discloses a not yet

configured Internet access device [see Abstract and Col. 9, Lines 20-24] and Internet

access device (100) connects to the Internet [see Abstract and Col. 9, Lines 13-17].

In addition, Li further teaches a second device that is configured and connected

to the network. For example, Li teaches a configuration server (410) connects to the

Internet [see Abstract and Figs. 8 & 9], wherein the second device sends over the

network at least a portion of its configuration information, wherein a portion of said

configuration information of said second device is used by said first device to create its

own configuration information. That is, Li discloses downloading a unique configuration

record from the configuration server (410) and then the Internet access device (100)

configuring itself for communication with the Internet using the configuration record [see

Abstract and Col. 12, Lines 43-48].

Regarding claims 1 and 9, the preamble of "... having devices that **may** comprise

one or more servers, hubs, routers, clients and switches ..." and the limitation of "...

which **may or may not be** a server, hub, router, client or switch ..." are being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. These amended portions render claims 1 and 9 indefinite and

clearly indicate that first or second device **is not required to be** a server, a hub, a

router, a client or a switch (no fixed designation). Moreover, other independent claims

24-25 do not even mention about a server, a hub, a router, a client or a switch at all.

Therefore, a first or a second device **is not required to be** a server, a hub, a router, a

client or a switch as argued by applicant [see Page # 8 of Remarks]. In summary, Li still

a proper reference with all limitations of the claim are found in the reference, or "fully met" by it.

As a result, cited prior art does disclose a system and method as broadly claimed by the applicant. Applicant has still failed to identify specific claimed limitations that would define a clearly patentable distinction over prior arts. Therefore, the examiner asserts that cited prior art teaches or suggests the subject matter recited in independent claims. Dependent claims are also rejected at least by virtue of dependency on independent claims and by other reasons shown above. Accordingly, claims 1-25 are respectfully rejected.

Conclusion

14.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A SHORTENED STATUTORY PERIOD FOR REPLY TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE MAILING DATE OF THIS ACTION. IN THE EVENT A FIRST REPLY IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CAR 1.136(A) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT, HOWEVER, WILL THE STATUTORY PERIOD FOR REPLY EXPIRE LATER THAN SIX MONTHS FROM THE MAILING DATE OF THIS FINAL ACTION.

15.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tran whose telephone number is (571) 272-3991. The Group fax phone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam, can be reached on (571) 272-3978.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Philip Tran

Philip Tran
Art Unit 2155
Feb 1, 2005

HOSAIN ALAM
ADVISORY PATENT EXAMINER